

In re application of

Tsuyoshi YAMANE et al.

Docket No. 2001\_1217A

Serial No. 09/941,693

Group Art Unit 1762

Filed August 30, 2001

RECYCLE SYSTEM OF AQUEOUS PAINT :

Confirmation No. 6192

## RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT

Assistant Commissioner for Patents, Washington, D.C.

IN THE MINISTER IN THE STREET AND DEPOSIT

Sir:

The Notice of Non-Compliant Amendment mailed December 14, 2001 indicates that the Amendment filed August 30, 2001 did not include a clean version of the amended claim, and did not include a marked-up version of the amended claim. This assertion is respectfully traversed.

A copy of the Preliminary Amendment filed August 30, 2001 is enclosed, together with a copy of a marked-up version of the amended claim as also filed on August 30, 2001. Only claim 6 was amended.

Thus, it is submitted that both the clean version of the amended claim 6 and the marked-up version of the amended claim 6 were submitted on August 30, 2001. In any event, copies of thereof are enclosed.

Respectfully submitted,

Tsuyoshi YAMANE et al.

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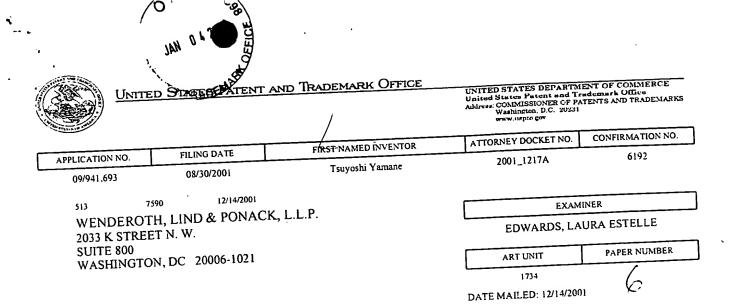
TC 1700

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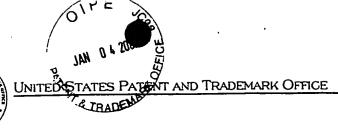


Please find below and/or attached an Office communication concerning this application or proceeding.

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APPLI	CATION NO. FII	ING DATE	FIRST NAMED INVENTOR	AT	TORNEY DOCKET N	
Γ			٦	EX	EXAMINER .	
				ART UNIT	PAPER NUMB	
				DATE MAILED:		
	Notice	of Non-Com	pliant Amendment (3	7 CFR 1.121)		
the for	The amendment of the mat required under 30.6.77, Sept. 19, 20	7 CFR 1.121, as amend	ed on September 8, 2000 (see 65 Fee	because it has not been I. Reg. 54603, Sept. 8, 2	submitted in 2000, and	
	1. The amendment does not include a clean version of the replacement paragraph(s)/section(s).  37 CFR 1.121(b)(1)(ii).					
	2. The amendment does not include a marked-up version of the replacement paragraph(s)/section(s).  37 CFR 1.121(b)(1)(iii)					
Þ	3. The amendment does not include a clean version of the amended claim(s). 37 CFR 1.121(c)(1)(i)					
P A D	4. The amendment does not include a marked-up version of the amended claim(s). 37 CFR 1.121(c)(1)(ii)					
'n	5. Other				<u>-</u> ·	
Þ	with revised 37	CFR 1.121 within O	Inless applicant re-submits the pre NE MONTH of the mail date of the originally proposed preliminary as ONE MONTH time limit is not e	us letter, examination mendment. This notice	1 OH THE HIGHE	
	fide, applicant	is given a TIME PER	AL ACTION: Since the above me IOD of ONE (1) MONTH or TH ger, within which to supply the om S OF THIS TIME PERIOD MAY	ission or correction i	n order to	
(ME	PEP Bookmark	Bulletin on "Sim	his correspondence is a cop plified Amendment Practio	y of an informati e").	onal flyer	
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## Changes to the Patent Rules

October 20, 2000

Volume 1, Issue 3

This is the third in a series of Patent News Bulletins to assist you in keeping up to date with significant rule changes which affect your area.

Keep this copy to use as a bookmark for your present MPEP, or view this bulletin again on the USPTO Website.

Simplified Amendment Practice.
Replacement paragraphs/sections/claims to be used. 37 CFR 1.121

Amendment by

replacement in clean form.

paragraph/claim <

The rule package
"Changes to the Patent
Business Goals - Final
Rule," published in the
Federal Register on
September 8, 2000, 65
Fed. Reg. 54603 (Sept.
8, 2000), and the Official
Gazette on

September 19, 2000, 1238 Off. Gaz. Pat. Office 77 (September 19, 2000). The PBG rule package makes a number of revisions to Title 37.

The entire final rule may be found at the USPTO Website at http:// www.uspto.gov/web/ offices/doom/olia/pbg/ Index.html.

Areas and Individuals
primarily affected by this
rule change Include:
(I)Patent Examiners and
Tech Support Staff in the
Technology Centers
(2) Office of Patent
Publication

Any questions related to this change in practice should be directed to Joe Narcavage, Special Projects Exr., (703-305-1795) or Liz. Dougherty, Legal Advisor, (703-306-3156) OPLA.

Mandatory compliance with the revised rule is not required until March 1, 2001. It is suggested that applicants adopt the revised procedures on or after November 7, 2000, in order to adjust to the changes in amendment practice.

Under the new amendment practice, amendments to the specification must be made by the submission of clean new or replacement paragraph(s), section(s), specification, or claim(s). This practice will provide a specification (including claims) in clean, or substantially clean, form that can be effectively captured and converted by optical character recognition (OCR) scanning during the patent printing process.

The new practice requires applicant to provide, in addition to the clean version of a replacement paragraph/section/claim, a marked-up version using applicant's choice of a conventional

marking system to indicate the changes, which will aid the examiner in identifying the changes that have been made. The marked-up version must be based on the previous version and indicate (by markings) how the previous version has been modified to produce the clean version submitted in the current amendment. The term "previous version" means the version of record in the application as originally filed or from a previously entered amendment.

The following format is suggested in an amendment paper: (1) a clean version of each replacement paragraph/section/claim with clear instructions for entry; (2) starting on a separate page, any remarks/arguments (37 CFR 1.111); and (3) starting on a separate page, a marked-up

version entitled "Version with markings to show changes made."

Applicants will also be able to submit a clean set of all pending claims, consolidating all previous versions of pending claims from a series of separate amendments into a single clean version in a single amendment paper. This submission of a clean version of all of the pending claims will be construed as directing the cancellation of all previous versions of any pending claims. No marked-up version will be required to accompany the clean version where no changes other than the consolidation are being made.

The amended rule encourages issuance of applications with an examiner's amendment without practitioners/applicants having to file a formal amendment. Additions or deletions of subject matter in the specification, including the claims, may continue to be

made in an examiner's amendment at the time of allowance by instructions to make any change at a precise location in the specification or the claims. An examiner's amendment may incorporate a printed copy of a fax or email amendment submitted by applicant. Only that part of the e-mail or fax directed to a clean version, or a portion of, a paragraph/claim to be added should be printed and attached to the examiner's amendment, with a paper copy of the entire e-mail or fax being entered in the file. The electronic version of the e-mail is not required to be saved once the printed e-mail (and any attachments) becomes part of the application file record.

MPEP 714+ & 1302.04

